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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,800	08/06/2001	Alex Francisco Galia		7397

7590

09/10/2003

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EXAMINER

CARIASO, ALAN B

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/921,800

Applicant(s)

GALIA, ALEX FRANCISCO

Examiner

Alan Cariaso

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 19, 2003 has been entered.

Claim Objections

2. Claim 18 is objected to because of the following informalities:

3. Claim 18, the term "plain" is an incorrect term associated with the "main beam intensity" or "sixty-degree". It appears that correct term intended would be —plane—. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-6 and 14-21 are rejected under 35 U.S.C. 102(b) as being anticipated by BRANDT (US 4,236,193).

6. BRANDT discloses a lighting system that illuminates a large outdoor playing field comprising: a plurality of illumination assemblies placed in predetermined locations (col.1, lines 50-54), each assembly comprising a support (16,17-fig.1), a support-receiving portion (18-figs.1-3), and a luminary (13) coupled to the support (16,17); the luminary (13-fig.6) comprising a lamp housing (13,23'-fig.6) that encloses a lamp (85,L), the lamp housing (13,23') having an open end (bottom opening adjacent ledge 65-fig.6), a lamp lens (71) mounted upon the open end (65), a reflector (86) disposed between the lamp (85) and the lamp housing (13,23'), and a light-blocking shield (88) about the open end (65) of the lamp housing; wherein each luminary (12,13) given the structure met inherently achieves full cut-off or zero candela intensity at an angle of ninety degrees above nadir (given the structure); and wherein each luminary (12,13) is coupled to a support (14) inherently achieving full cut-off; wherein the outdoor playing field comprises at least a ball field (col.1, line 53); wherein the illumination assemblies comprise a plurality of luminaries (12,13); wherein a first luminaire (12-figs.1 & 3) is mounted behind a second luminaire (13-figs. 1 & 3); wherein the luminaire comprises an optical assembly (L,86,71,88) having or maintaining an inherently main candle power distribution or intensity of light in about 60 degree (as best shown by representative light lines in fig.6); wherein the luminaire does not emit light about the eighty-five degree plane (from fig.6, line tracing of direct line of light from the light source (L) bounded by the edge of frame (64) is measured to be not above 85 degrees); wherein the luminaire (12,13) is coupled to the support (14) at an angle (90 degree given its elevation about ground) above the horizontal plane .

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 3, 7 and 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over BRANDT (US 4,236,193) in view of ARMSTRONG (US 5,274,534).

9. BRANDT discloses applicant's invention except: a football field and soccer field as the outdoor playing fields; at least 40 feet height to which the luminaire is mounted; placement of the lighting system about a periphery of the playing field; and method steps of removing all non full cut-out luminaries, registering with a local government, and canvassing a local community to show the installation.

10. In regards to the football and soccer fields, at least 40 feet height to which the luminaire is mounted, and placement of the lighting system about a periphery of the playing field, ARMSTRONG teaches an illumination system of plural luminaries positioned at a periphery of the large outdoor playing field (fig.6), each luminaire being mounted at least 40 feet in height (col.2, lines 29-32), and the playing fields used for at least soccer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the lighting system of BRANDT positioned at the periphery of the playing field and mounted at heights of at least 40 feet as taught by

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ARMSTRONG in order to illuminate outdoor playing fields such as soccer field and a field-equivalent of a football field at night.

11. In regards to method steps of removing all non full cut-out luminaries, registering with a local government, and canvassing a local community to show the installation, ARMSTRONG does teach an improvement (reduced glare, reduce adverse illumination impact on the neighborhood) of using cut-off luminaires over a conventional outdoor lighting system which are non cut-off (cols.1 & 5) which are sought by spectators and neighborhood residents (col.1) over the problems of a conventional light system established in the playing field and and that it is a well known business practice to demonstrate aspects of a product which will produce a desired result upon installation. Therefore it would have been obvious to one having ordinary skill in the art at the time of applicant's invention that installation of the lighting system of BRANDT or ARMSTRONG would include removal of the conventional lighting system and canvassing the local community to show this improvement. It is also obvious to one having ordinary skill in the art at the time of applicant's invention to register with the local government since it is well known that most lighting systems installed in any community has a local government regulating any such construction requiring registration thereof. Otherwise, no registration would mean no installation of any public lighting system in a community that is government regulated.

Response to Arguments

12. Applicant's cancellation of claims 8 and 22 is acknowledged. Claims 1-7 and 9-21 remain pending. However, applicant's remark that claims 8 and 22 had "formalities" is partially incorrect. In the Final Office Action of January 16, 2003, the claim objections were directed to claims 18 and 22, and not 8. As presently stated above, the claim objection to claim 18 remains.

13. In response to applicant's argument that the present invention is limited in the Claims to "full cut-off" lighting not taught by Armstrong nor Brandt, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

14. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the problem of spill-effect lighting) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

15. This is a continued examination of applicant's Application No. 09/921,800. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (703) 308-1952. The examiner can normally be reached on 9-5:30 M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone number

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for the organization where this application or proceeding is assigned is (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

AC
September 5, 2003



ALAN CARIASO
PRIMARY EXAMINER